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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/395,038 09/13/99 TRINCHIERI

G WST85USA

EXAMINER

HM12/0828

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PRASAD, S	
ART UNIT	PAPER NUMBER

1646
DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/395,038

Applicant(s)

Trinchieri et al.

Examiner

Sarada C Prasad

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 40-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Action

1. Receipt of Applicants' arguments and amendments filed in Paper No. 10 (6/14/01) is acknowledged. Amendment to claims 1, 40-41 has been entered, claims 16-39 have been cancelled, and new claim 42 has been added. Currently, original claims 2-15; amended claims 1, 40-41; and new claim 42 are under consideration.
2. The following previous rejections and objections are withdrawn in light of Applicants' amendments filed in Paper No. 10 (6/14/01).
 - (i) the rejection of claims 1-15, 40, 41 under 35 U.S.C. 112, second paragraph based on use of the phrase 'and/or', and based on recitation of 'use';
 - (ii) the rejection of claim 40 under 35 U.S.C. 101, based on non statutory subject matter.
3. Applicant's arguments filed in Paper No. 10, 6/14/01, have been fully considered but were deemed persuasive in part. The issues remaining and new issues, are stated below.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

5. Claims 1-15, 40-41^{4-b} are rejected under 35 USC § 103 in Paper No.9 (3/14/01).

This rejection of record is being maintained for reasons of record set forth in pages of the previous office action (Paper No. 4, 3/14/01). This rejection now applies to claims 1-15, 40-41 and 42.

Applicant's arguments filed in Paper No. 10 (6/14/01) have been fully considered but they are not persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 5, last paragraph, line 1-page 6,

Art Unit: 1646

end of paragraph), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In fact, the Applicants themselves point out a comment on page 5851 of Fecho et al. "For instance, IL-4, IL-10 and TGF- β synergistically inhibit IFN- γ -induced NO synthesis in murine macrophages' suggesting the interplay between cytokines in the induction and modulation of NO synthesis by macrophages. Thus, there is already a suggestion of the combined effects of cytokines and macrophage derived NO in Fecho et al. directed to the relevance of the instant obviousness type rejection.

Furthermore, in response to applicant's argument that there is no suggestion to combine the references (lines bridging pages 5-6 of the applicants' response, Paper No. 10, 6/14/01), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, the art recognized diverse and undesirable side effects of IL-12 indicate the benefits of lowering the doses of adjuvanting amounts of IL-12 for administration. This can only be achieved by supplementing with additional molecules that enhance the adjuvanting effect of the lower amounts of IL-12 administered. One of skill in the art looking for such additional

Art Unit: 1646

molecules that enhance the adjuvanting effects of cytokines, of IL-12 in particular would find the teachings of Fecho et al. as obvious. Based on these considerations, the rejection of record is being maintained.

Conclusion

6. No claims are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1646

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarada C Prasad whose telephone number is 703-305-1009. The examiner can normally be reached Monday – Friday from 8.00 AM to 4.30 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Sarada Prasad, Ph.D.
Examiner
Art Unit 1646
August 24, 2001

Prema Mertz
PREMA MERTZ
PRIMARY EXAMINER